

### **REMARKS**

This Application has been carefully reviewed in light of the non-final Office Action mailed November 29, 2007 (the "Office Action"). As of the date of the Office Action, claims 1-30, 32-41, 58, 82-84, 153, 154, 156, 158 and 161-166 were pending in this application. Claim 166 has been cancelled in this amendment without prejudice. New claim 167 has been added in this amendment. Claims 1-5, 12-14, 39-41 and 82-84 have been allowed.

Applicants have amended the claims to cancel Claim 166 and to add Claim 167 in order to more fully encompass the basic concept of the described invention. It is believed readily apparent that Claim 167 is specifically supported by the specification.

Applicants respectfully traverse the rejection of Claims 6-11, 15-30, 32-38, 58, 153, 154, 156, 158 and 161-165, all such rejections based principally upon *Hartung, et al.*, by itself or in combination with other secondary references. In particular, Applicants request reconsideration of the Examiner's decision that Applicants have not presented sufficient proof to establish conception of the invention prior to the April 4, 1994 effective date of the *Hartung, et al.* reference, nor sufficient proof of diligence during the requisite time period, i.e., just prior to April 4, 1994 until Applicants' August 14, 1995 date of filing its application for U.S. Patent 5,630,363 ("the '363 patent"). In additional support of this request for reconsideration, Applicants submit herewith the Supplemental Declaration of Bill L. Davis under 37 C.F.R. 1.131 ("Davis Supp. Dec."). This Declaration should be considered in conjunction with the prior declarations of record, and in particular the 09/22/2000 Declaration of Jesse Speight Williamson, filed on September 26, 2000. ("Prior William Declaration").

### **Conception**

Applicants do not dispute the Examiner's recitation of the law that proof of conception by Applicants require that they either submit demonstrative evidence of conception or, alternatively, corroborated evidence of a complete disclosure to another. Applicants also do not dispute that conception is more than a vague idea of how to solve a problem, but requires that there be at least the "formation in the mind of the inventor" a "definite and permanent idea" of a means for implementing the idea. *See, e.g., Sewall v. Walters*, 21 F.3d 411, 30 USPQ2d 1356 (Fed. Cir. 1994). It is respectfully submitted that the accompanying Supplemental Declaration of Bill L. Davis, particularly when taken in conjunction with the Prior Williamson Declaration, provides the requisite corroboration of, as well as proof of the definite and permanent nature of, the invention's conception.

The law is clear that in a situation, like here, where one of two named co-inventors of a patent is the sole inventor of certain ones of the claims of the patent, the other named co-inventor, who is not a co-inventor of those claims, may provide the requisite corroboration of the details of the other inventor's

conception and of the date of that conception. *Petersen Mfg. Co., Inc. v. Adjustable Clamp Co., Inc.*, 30 USPQ2d 1193, 1197 (N.D. Ill. 1993). Moreover, the fact that the corroborating witness may also be affiliated with the sole inventor's company or may work with the sole inventor is not a basis for rejecting the corroborative value of the testimony. *Environ Products, Inc. v. Furon Co.*, 47 USPQ2d 1040, 1043 (E.D. Pa. 1998), *aff'd & remanded*, 215 F.3d 1261, 55 USPQ2d 1038 (Fed. Cir. 2000).

As attested to in paragraph 3 of the Davis Supp. Dec., Mr. Davis, a named co-inventor on the '363 patent, played no role in the conception of the basic concept of the '363 patented invention (i.e., that concept which is disclosed in the *Hartung* patent), namely "printing apparatus, and a method of using such apparatus, in which successive flexographic and offset lithographic printing units or 'stations' are arranged for continuous in-line printing of a substrate, with a flexographic printing station or stations upstream from an offset lithographic printing station." As stated by Mr. Davis, this was the sole invention of Jesse Williamson, for which Mr. Davis was not a co-inventor. Consequently, Mr. Davis legally qualifies, and is more than competent, to testify as to Mr. Williamson's conception disclosure, and corroborate Mr. Williamson's testimony in the Prior Williamson Declaration regarding such conception.

Mr. Davis then testifies, [¶¶ 4 and 5, of Davis Supp. Dec.], in great detail about what Mr. Williamson disclosed to him regarding the conception of the aforementioned combined lithographic/flexographic invention including, *inter alia*, what objectives Mr. Williamson was seeking, when and how Mr. Williamson came up with the invention, and the specific structural alternatives he had contemplated for implementing his invention. For example, and as averred to by Mr. Davis, Mr. Williamson disclosed to Mr. Davis that for a dedicated flexographic station, Mr. Williamson was contemplating using "a tower coater with an anilox roller" (which Mr. Davis confirms to be a well-known form of flexographic printing unit.) [¶ 4, Davis Supp. Dec.] Mr. Williamson even described the different types of auxiliary add-on units he was contemplating. [¶ 5, second sentence, Davis Supp. Dec.]

It is respectfully pointed out that the corroborating recollection of Mr. Davis as to what Mr. Williamson disclosed to him in May 1992, is completely consistent with the conception testimony of Mr. Williamson himself in the Prior Williamson Declaration [*see, e.g.*, ¶¶ 6-8, Prior Williamson Declaration], including Mr. Williamson's recollection in paragraph 8 of Prior Williamson Declaration of what he remembered telling Bill Davis. It is therefore contended that the testimony of, and disclosure to, Mr. Davis by Mr. Williamson of his invention, as stated in the Prior Williamson Declaration, in combination with the corroborating testimony of Mr. Davis in the Davis Supp. Dec., more than meets the legal requirement for proof of conception and date of conception.

### **Reduction to Practice**

It is also respectfully contended that, particularly when taking into consideration Mr. Davis' succinct sworn summary of the diligent steps taken to reduce Mr. Williamson's invention to practice (§§ 6-9 of Davis Supp. Dec.), it can only be concluded that every action which could reasonably be expected to be taken, between the relevant time frame of just before April 4, 1994 to the August 14, 1995 date of filing of the application for the '363 patent, was carried out. In this regard, the Examiner is reminded that an actual reduction to practice of the invention required the successful operation of an in-line integrated arrangement of flexographic and offset lithographic printing units. However, no such equipment existed on the market in 1994, [¶ 7, Davis Supp. Dec.]. Moreover, Williamson Printing was not, and still is not, a manufacturer of either the required printers or the auxiliary equipment needed to implement the invention. As detailed in Mr. Davis' Supplemental Declaration (and in the other declarations on file), it took time before Williamson Printing could acquire the first prerequisite of the in-line assembly—namely the lithographic presses. However, after procuring these presses in July 1994, the inventors immediately addressed the need to integrate the upstream flexographic print station with the lithographic print unit. Indeed, as detailed by Mr. Davis in paragraph 7 of the Davis Supp. Dec., to save time, they were pursuing parallel tracks for this integration, the purchase from Printing Research, Inc. of a retractable “rack-back” auxiliary mechanism modified with an anilox roller and a chambered doctor to provide the flexographic printing unit, as well as a parallel effort with Heidelberg to develop a dedicated flexography unit. [See, §§ 7 and 8 of Davis Supp. Dec.]

However, in addition to the diligence exerted to actually reduce the invention to practice, as previously described, beginning in December 1994, and continuing until August 14, 1995, the inventors were diligently pursuing the constructive reduction to practice of the invention—the filing of the application for the '363 patent. As detailed in paragraph 9 of Davis Supp. Dec., Mr. Davis and Mr. Williamson diligently proceeded with the normal sequence of activities required to protect an invention, namely an initial search, a review of the prior art patents turned up in the search, and meeting with their patent agent. [Ex. 1, ¶ 9, Davis Supp. Dec.]. Thereafter followed, the sequence of drafting and re-drafting of the draft of the patent application that is typical of the careful preparation of a U.S. patent application. [Ex. 2, ¶ 9, Davis Supp. Dec.].

The law is clear that in proving diligence, a party is legally permitted to “tack” the events constituting the diligence leading to a constructive reduction to practice with the prior diligence leading toward the actual reduction to practice. *See, e.g., Gammeter v. Backdahl*, 50 App. D.C. 45, 1920 C.D. 209 (1920). It is believed readily apparent that when taking into consideration the relatively short time frame between April 4, 1994 and August 14, 1995, the activity that was being carried out by the inventors

to actually reduce their invention to practice coupled with the activity that was carried out to constructively reduce such invention to practice, not only was diligent, but exceedingly expedient.

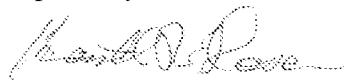
Finally, Applicants attorney wishes to clarify what appears to be a misunderstanding. In pointing out the large expense of printing presses, and the caution that was exerted by Williamson Printing, as summarized in Applicants' 9/30/2005 response, it was not intended to convey the impression that a financial hardship was the reason for any delay. Such delay, if any, was caused by the fact that Williamson Printing needed to rely on others to manufacture the auxiliary equipment that was needed to provide the integrated in-line system. If Williamson Printing had been a manufacturer of printing presses or of the required auxiliary equipment, undoubtedly they would have been able to move along at a slightly faster pace.

In conclusion, Applicants respectfully request that the Examiner withdraw the *Hartung* reference as prior art, and in view of such withdrawal, allow Claims 6-11, 15-30, 32-38, 58, 153, 154, 156, 158, 161-165, and newly added Claim 167.

### **Conclusion**

To the extent that any further fees are required during the pendency of this Application, including petition fees, the Commissioner is hereby authorized to charge payment of any additional fees, including, without limitation, any fees under 37 C.F.R. § 1.16 or 37 C.F.R. § 1.17, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and reference Attorney Docket No. 111667-1000. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account. This is intended to be a complete response to the Office Action mailed November 29, 2007.

Respectfully submitted,



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